

Application Number 10/731,638  
Responsive to Office Action mailed March 7, 2006

### REMARKS

This submission is responsive to the Office Action dated March 7, 2006. Claims 1-23 remain pending.

#### Claim Rejection Under 35 U.S.C. § 102

The Office Action rejected claims 1, 3, 5, 6, 8-10, 17-23 under 35 U.S.C. § 102(e) as being anticipated by U.S. 6,358,281 to Berrang et al. (Berrang). Applicant respectfully traverses the rejection. Berrang et al. fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. § 102(e), and provides no teaching that would have suggested the desirability of modification to include such features.

For example, Berrang fails to disclose or suggest a flexible overmold that covers a second module and partially covers a first module wherein the first module housing extends out of the overmold for receipt in a first recess in a cranium of a patient, as required by independent claim 1. Further, Berrang fails to disclose or suggest a first module housing with a height  $H_1$  greater than a height  $H_2$  of a second module housing, and wherein the first module housing with the greater height extends out of an overmold for receipt in a first recess in a cranium of a patient, as required by independent claim 23.

In support of the rejection of independent claims 1 and 23, the Office Action merely pointed to FIGS. 1 and 2 of Berrang and stated that "fig. 2...shows housings 2 and 3 which are partially covered in an overmold, and fig. 1...shows another housing 1 which includes a coil...."<sup>1</sup> In fact, with the exception of one other sentence, this statement represents the entirety of the Office Action's analysis for the numerous requirements of claims 1, 3, 5, 6, 8-10, 17-23. The analysis fails to address numerous requirements of the claims, or provide any clue as to the Office's interpretation of Berrang.

As one notable example, the Office Action does not even identify which of the elements in FIGS. 1 and 2 of Berrang is being interpreted as meeting the requirement in Applicant's claims of an overmold. It is essentially impossible for Applicant to provide a coherent response without understanding which element depicted in FIGS. 1 and 2 of Berrang the Office considers to be an overmold. Further, what little analysis is provided in the Office Action is incorrect. For

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<sup>1</sup> Office Action, Page 2.

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example, contrary to the one of the few statements in the Office Action, Berrang does not disclose housings 2 and 3. Instead, Berrang discloses a single housing comprising housing sections 2 and 3.<sup>2</sup>

In any event, Applicant's careful consideration of FIGS. 1 and 2, as well as the rest of Berrang, does not reveal any disclosure of a flexible overmold that covers a second module and partially covers a first module wherein the first module housing extends out of the overmold for receipt in a first recess in a cranium of a patient, as required by independent claim 1. Applicant notes that Berrang only describes that, "wire 12 [of coil 4] is preferentially encapsulated in a bioinert polymer layer 13..."<sup>3</sup> Applicant further notes that Berrang does not suggest that layer 13 partially encapsulates either of housing sections 2 and 3. Accordingly, layer 13 is not an overmold that that covers a second module and partially covers a first module wherein the first module housing extends out of the overmold for receipt in a first recess in a cranium of a patient, as required by independent claim 1. Furthermore, Berrang also does not suggest that any of the layers of housing sections 2 and 3 extend to cover coil 4. There does not appear to be any element in FIGS. 1 and 2 that both covers one module and partially covers some other module.

Additionally, with respect to independent claim 23, Berrang does not suggest that housing sections 2 and 3 differ in height. Berrang states that "The housing thickness of sections 2 and 3 is about 2.0 to 2.9 mm..."<sup>4</sup> However, thickness of the housing sections is never described as varying between sections 2 and 3. Further, FIG. 2 illustrates that sections 2 and 3 are relatively identical in height. Accordingly, Berrang does not disclose or suggest a first module housing with a height  $H_1$  greater than a height  $H_2$  of a second module housing, and wherein the first module housing with the greater height extends out of an overmold for receipt in a first recess in a cranium of a patient, as required by independent claim 23.

Berrang fails to disclose each and every limitation set forth in claims 1, 3, 5, 6, 8-10, 17-23. For at least this reasons, the Office Action has failed to establish a prima facie case for anticipation of Applicant's claims 1, 3, 5, 6, 8-10, 17-23 under 35 U.S.C. § 102(b). Withdrawal of this rejection is requested.

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<sup>2</sup> Berrang, col. 9, ll. 51 and 52.

<sup>3</sup> Berrang, col. 10, ll. 23-24.

<sup>4</sup> Berrang, col. 10, ll. 4-5.

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Furthermore, Applicant respectfully suggests that the brief rejection of Applicant's claims is contrary to the requirements of 37 C.F.R. § 1.104. Accordingly, if the rejection of the claims based on Berrang is maintained, Applicant respectfully requests a more detailed rejection.

### Claim Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 2, 4, 7, 11-13 under 35 U.S.C. § 103(a) as being unpatentable over Berrang. The Examiner also rejected claims 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Berrang in view of U.S. 6,308,101 to Faltys et al. (Faltys). Applicant respectfully traverses these rejections. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

As an initial matter, Applicant notes that Faltys does not provide any teaching that would overcome the basic deficiencies of Berrang with respect to the requirements of Applicant's independent claims discussed above. For at least that reason, claims 2, 4, 7 and 11-16 are patentable over the applied references.

Furthermore, claim 4 requires that the second module includes a second module housing containing the recharge coil. The Office Action acknowledged that Berrang fails to disclose or suggest this requirement of claim 4, but stated that "a housing is considered to have been obvious in that such would serve to protect the coil from damage."<sup>5</sup> However, the Examiner has cited no evidence of this supposed motivation in the prior art, nor any teaching of this feature within the prior art, as required for a prima facie case of obviousness.

Additionally, claim 11 requires that the first operative component includes a power source within the first module housing, wherein the power source provides power to the control electronics and therapy delivery circuit. Berrang does not suggest the elements of claim 11, but the Office Action suggested that it would have been an obvious design choice to include the battery in housing section 2, as opposed to housing 3. Assertions of "design choice" are an inadequate basis for a prima facie case of obviousness as a matter of law.<sup>6</sup>

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<sup>5</sup> Office Action, Page 2.

<sup>6</sup> *In re Lee*, 61 USPO2d 1430 (CAFC 2002).

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Furthermore, this design choice would go against the goals put forth by Berrang. Berrang states that, "the housing sections 2 and 3 should be as thin as possible to minimize the "bump" on the skin overlaying the housing sections 2 and 3."<sup>7</sup> Including a power source within the first module housing would increase the thickness of housing section 2, and prevent housing section 2 from being as thin as possible. Therefore, a person of ordinary skill in the art would have consciously avoided including a power source within the first module housing of the Berrang device, in the manner suggested by the Examiner.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 2, 4, 7, 11-13 and 14-16 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

### CONCLUSION

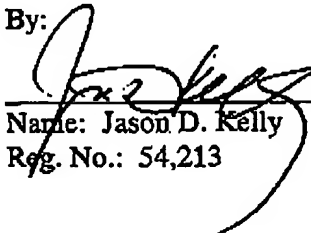
All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

7/5/06

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<sup>7</sup> Berrang, Col. 9, ll. 63-65.